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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,105	09/23/2003	William A. Goldman	074263.0170	4083

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EXAMINER

DANG, HOANG C

ART UNIT PAPER NUMBER

3672

DATE MAILED: 04/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/669,105	Applicant(s) GOLDMAN ET AL.	
	Examiner Hoang Dang	Art Unit 3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2006.
 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15, 17-24 and 34-39 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1-15, 17-24 and 34-39 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/9/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 26, 2006 has been entered.

Claim Objections

2. Claim 11 is objected to because of the following informalities: In line 10, "selecta" should be --select a--. Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1, 2, 7-11, 15, 17-18, 22-24 and 34-39 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Millheim (US 4,794,534) (see the Abstract; the flow chart of Figures 2A-2B; column 3, line 65 through column 5, line 15; column 6, line 60 through column, line 36; and column 9, line 47 through column 11, line 27 for examples).

It is noted that all of the steps called for in the claims are carried out in the "predictive" (col. 2, line 67) engineering simulator shown in Figures 2A or/and 2B.

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 3-6, 12-14 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Millheim '534.

Millheim discloses the invention as claimed except that Millheim does not disclose the steps of limiting the predicted drilling performance for the proposed drilling equipment to a certain depth in the given formation, recommending the drilling equipment for use with the drilling system at the certain depth or displaying the recommended drilling equipment at the certain depth in the given formation. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to limit, recommend or display the "acceptable results" provided by the engineering simulator of Millheim to (with) the certain depth involved with the associated input parameters since one of ordinary skill in the art would have readily recognized that input parameters and thereby their "acceptable results" change with depth as the drill bit penetrates deeper into the formation.

Response to Arguments

7. Applicant's arguments filed January 26, 2006 have been fully considered but they are not persuasive. Contrary to applicant's argument, Figs. 2A and 2B show that new (changed) drilling parameter(s) is fed into the simulator if the result from the simulator for the previous drilling parameter is not acceptable. The first or previous drilling parameter corresponds to the "first

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proposed drilling equipment". The new (changed) drilling parameter corresponds to the "second proposed drilling equipment". The result provided by the simulator for the new (changed) parameter is the "predicted drilling performance" for the "second proposed drilling equipment". The predicted drilling performances for the first and second proposed drilling equipment in Millheim '534 are inherently compared when the results from the simulator are determined as "acceptable" or "unacceptable".

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoang Dang whose telephone number is 571-272-7028. The examiner can normally be reached on 9:15-5:45 Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoang Dang
Primary Examiner
Art Unit 3672

